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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,843	06/30/2000	Kia Silverbrook	NPA063US	2333

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, NSW 2041
AUSTRALIA

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/607,843	Applicant(s) SILVERBROOK ET AL.	
	Examiner Narayanswamy Subramanian	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,8-21,23-29,31,36-44 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,8-21,23-29,31,36-44 and 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicants' request for continued examination filed on June 8, 2006. Amendments to claims 1, 3, 8, 21, 23, 24, 29, 36, and 47 have been entered. The status identifier of claim 44 is incorrect. Rejections made under the second paragraph of 35 USC § 112 are withdrawn in view of the amendments. Claims 1, 3, 8-21, 23-29, 31, 36-44 and 46-48 are pending in the application and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1, 3, 8-21, 23-29, 31, 36-44 and 46-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 29 recite the limitations "determining a unique page identity for said form in a computer system; determining a page description for said form in the computer system, said page description comprising: (i) a description of said graphical banking information and (ii) a description of an interactive banking element, which includes a zone of said interactive banking element on said form; sending page identity data and data regarding said graphical banking information together to a printer networked with the computer system, thereby enabling the printer to print the form". In the preamble the applicant recites "A method of enabling online banking via a printed form". It is not clear how the determining steps are performed for the printed form before the form is printed. The metes and bounds of this limitation are

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indeterminate. Also the limitation “thereby enabling the printer to print the form” is only an intended use of the sending step. There is no limitation to indicate that the printing step is actually performed. Also it is not clear what the applicant means by the term “an interactive banking element”. It is not clear as to what is the relationship between “plurality of locations on the form” recited in the preamble and the body of the claim. It is also not clear as to what is the association between page description and page identity. Appropriate correction/clarification is required. Claims 3, 8-21, 23-28, 31, 36-44 and 46-48 are rejected by dependency. The art rejection below is made in the light of this 35 USC 112, second paragraph rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 8-21, 23-29, 31, 36-44 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al (US Patent 6,330,976 B1) in view of Richards et al (US Patent 6,539,361 B1) as discussed in paragraph 5 of the final rejection mailed on April 20, 2006.

6. Claims 21, 23, 28, 44, 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al (US Patent 6,330,976 B1) in view of Richards et al (US Patent 6,539,361 B1) and further in view of Sekendur (WO 97/22959) as discussed in paragraph 6 of the final rejection mailed on April 20, 2006.

Response to Arguments

7. In response to Applicant's arguments that Dymetman does not describe a computer system which is configured to print graphical banking information and coded data on demand, the examiner would like to point out that there is no limitation in the independent claims that recite "printing both graphical banking information and coded data on demand". In fact in claim 1, the printing step is not even positively recited.

Applicant's other arguments with respect to pending claims 1, 3, 8-21, 23-29, 31, 36-44 and 46-48 have been considered but are not persuasive.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sub Sough can be reached at (571) 272-6799. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Dr. N. Subramanian

August 14, 2006